

8. (Once amended) The data card display package according to claim 7, wherein said aperture is diecut into a peripheral edge of said first side [panel].

9. (Once amended) The data card display package according to claim 5, wherein said aperture is a diecut window fully disposed in and bordered on four sides by said first side [panel].

10. (Once amended) The data card display package according to claim 9, wherein said aperture is diecut centrally in said first side [panel].

11. (Once amended) The data card display package according to claim 7, wherein the first side [panel] of said backing is folded over the data card and onto the second side [panel] of said backing, and said first and second side [panel] margins are bonded around the data card to partially secure the data card therein, [.] a portion of the first and second sides of said data card outwardly extending from said package.

13. (Once amended) The data card display package according to claim 5, further comprising a plurality of perforations disposed in said side [panel] margins for opening the package, wherein separation of the perforations permits the package to unfold to reveal a printed interior of said first and second sides [panels].

#### REMARKS

The present application was filed pursuant to 35 U.S.C. § 251 as a reissue application of U.S. Patent No. 5,842,629 filed on August 9, 1996 and granted on December 1, 1998. Claims 5, 7-11, and 13 are amended and claims 1-5, 7-11, and 13-14 are pending in the application.

Further consideration and allowance of this application are respectfully requested.

The Examiner rejected the drawing of FIG. 6, filed on February 16, 2000, stating that it introduces new matter (the width dimension 4.182") into the drawings in violation of 37 CFR 1.121(a)(6). The drawing is an unchanged representation of FIG. 6 of the original patent, which figure reflects a pro se drawing change (adding the width dimension 4.182") that was sent separately to the "Drawing Review Branch" and escaped the Examiner's consideration. The amended FIG 6 was published. New matter includes the addition of wholly unsupported subject matter after a broader original disclosure. See In re Wertheim, 541 F.2d 257, 191 USPQ 90 (CCPA 1976). Figure 4 (and others) as originally filed shows the width dimension 5.5" with perforated margins intact, and it shows the dimensions of the perforated margins as .375". The description of Fig. 6 makes it clear that the disputed width dimension is equal to the width dimension 5.5" with the .6875" perforated margin removed. It would be obvious to one skilled in the art that  $5.5 - .6875 = 4.8125$ . "By disclosing in a patent application a device that inherently...has a property... even though it says nothing explicit concerning it...The application may later be amended to recite the [property] without introducing prohibited new matter." In re Reynolds, 443 F.2d 384, 170 USPQ 94 (CCPA 1971); In re Smythe, 480 F. 2d 1376, 178 USPQ 279 (CCPA 1973); M.P.E.P. 2163.07(a). The contested dimensioned was clearly inherent and does not constitute new matter.

Next, the Examiner objected to the abstract of the disclosure because the term "VERI MAG PACK" was capitalized. The name is not a registered trademark. Therefore, in compliance with the Examiner's suggestion, applicants have herein amended all references to the name "VERI MAG PACK" in the specification be amended to read "Veri Mag Pak."

Next, the Examiner objected to the specification as failing to provide the proper antecedent basis for the claimed subject matter. Applicants respectfully submit that the terms "opaque backing", "transparent layer", and "display window" do find antecedent basis in the specification. The first term "opaque backing" used in claim 5 finds antecedent basis in the specification on page 9, line 19 which reads: "The *back* side 32 is made of *opaque* paper board that completely covers the back . . .". The term "transparent layer" also used in claim 5 finds

antecedent basis in the specification on page 7, lines 17-19 which read: "A diecut window is formed in the front side 31, and a *transparent cellophane layer* is glued across the window . . . " (italics added for emphasis). The rejected term "display window" as used in claim 5 describes the diecut window with transparent cellophane described above (e.g., the function of the transparent layer), and it finds ample antecedent basis in the above quoted language of the specification.

Applicants have herein requested that the terms "first panel", "second panel", "first panel margin", "second panel margin", and "aperture" be amended as follows to render the terms as used in the claims more definite. The term "panel" should be changed to "side". The amendment to the Specification, as requested above, gives the term "aperture" an antecedent basis in the claims.

The Examiner raised two issues which cut to the heart of this reissue application. The first issue addresses the introduction of "new matter" into the disclosure of the invention under 35 U.S.C. §132, found in the Examiner's report at number 4. The second issue is one of recapture under 35 U.S.C. §251 which the Examiner contends is as a basis for rejecting claims 5 -15, and is found in the Examiner's report at number 7. These two points will be addressed first.

The Examiner states that certain material was improperly added into the disclosure of the reissue application, and that such additions are prohibited under 35 U.S.C. §132.<sup>1</sup>

First is the matter of allegedly introducing patents as prior art. The "Fundamental inquiry under 35 U.S.C. §132 is whether material added by amendment was inherently contained in original application..." The prior art is what it is, and Applicant's additions to the background section were made with the intent to fully and fairly disclose the relevancy of prior art that was not known to the applicant during original prosecution. Applicant is content

---

<sup>1</sup> Applicant notes that the present application is a reissue application under 35 U.S.C. § 251 and is not subject to 35 U.S.C. §132, and yet the former section has its own prohibition that "[n]o new matter shall be introduced into the application for reissue".

to rely on the Information Disclosure statement filed with the present reissue application to accomplish this. Accordingly, the prior art discussion is herein cancelled from the specification.

Continuing with the theory that applicants attempted to introduce new matter into the application, the Examiner rejected certain individual words or phrases added to the specification. Specifically, the Examiner rejected the addition of the words "with exemplary dimensions of approximately" at line 11 of page 7, and the word "approximately" at line 12 of page 8 both of which describe the size of the package. The purpose of the additions was merely to take the dimensions shown in the original drawings and reflect them literally in the specification. The Examiner apparently takes issue with applicant's characterization of these sizes as "exemplary", "approximate" or "preferable". However, the dimensions are not reflected in the claims. "Absent any suggestion that the inventor intended expressly to limit the claimed elements, it might be argued that the limitations of size and weight inherent in the invention operate within a range of sizes and weights which would be readily understood by anyone skilled in the art. In re Burke Inc., 22 USPQ2d 1368, 1698 (DC Calif 1992).

Employing a "new matter" analysis in an analogous situation, the court in In re Heinle, 342 F.2d 1001, 145 USPQ 131 (CCPA 1965) reversed a PTO rejection of the applicant's claims to a "toilet paper core" as "including subject matter having no clear basis in the application as filed." Id. at 1003, 145 USPQ at 133. The claim limitation said to be without support required that the width of the apertures in the core be "*approximately* one-fourth of the circumference of said core." Id. at 1007, 145 USPQ at 136. The court stated: "it seems to us that [the drawings] conform to the one-fourth circumference limitation almost exactly. But the claim requires only an approximation. Since we believe an amendment to the specification to state that one-fourth of the circumference is the aperture width would not violate the rule against "new matter," we feel that supporting disclosure exists. The rejection is therefore in error." Id. The foregoing precedent deals with the same type of characterizations added in the claims. Applicant has only added to the specification, and the

authority is on point. Consequently, the word "approximately" is inherently supported by the original application and is not new matter. The term "preferably" implies no advantage to the printing, but only implies that the illustrated invention is the best mode. This is also inherently supported by the original application and is not new matter. The change from "exposing" to -normally exposed- is merely a grammatical correction and infers no change in degree. With respect to the last paragraph, this is a matter of good form found in virtually every professionally-prepared patent application and is an inherent statement of the obvious.

Next, the Examiner rejected claims 5-15 under 35 U.S.C. §112 as being indefinite for failing to particularly point out and distinctly claim the subject matter regarded as the invention. Specifically, the Examiner states that it is indefinite whether applicants are including the data card as an element or not. Claim 5 has been amended to further define the data card in the preamble. This is believed to provide full and proper antecedent basis for all subsequent references to *the data card* appearing throughout claim 5 and its dependents. The invention is clearly stated to be a "data card display package", and applicant believes that it is clear that the data card is not and need not be recited as a positive element. Applicants believe that claim 5 as amended rectifies any indefiniteness and ambiguity perceived by the Examiner. Finally, claim 12 has been canceled, and claim 11 has been amended as shown above to eliminate the double recitation as directed by the Examiner.

The Examiner next rejected claims 5-15 as being an improper recapture of claimed subject matter surrendered in the application for patent upon which the present reissue is based. "The recapture rule bars the patentee from acquiring, through reissue, claims that are of the same or of broader scope than those claims that were cancelled from the original application." Ball Corp., 729 F.2d at 1436, 221 USPQ at 295 (citations omitted). However, the recapture rule does not apply where there is no evidence that amendment of the originally filed claims was in any sense an admission that the scope of that claim was not in fact patentable. Seattle Box Co. v. Industrial Crating & Packing, Inc., 731 F.2d 818, 826, 221 USPQ 568, 574 (Fed. Cir. 1984).

Clement, 131 F.3d at 1464,1468, 45 USPQ2d 1161, 1164, states that the application of the recapture rule must begin with a determination of whether and in what respect the reissue claims are broader than the original patent claims.<sup>2</sup> The Examiner has not met his burden on this initial point, but focuses entirely on the "broadening aspect" present in the reissue. There is only a general assertion that this broadening aspect "relates to subject matter that applicant previously surrendered during the prosecution of the application." The Examiner does not specify any particular subject matter of new claims 5-15 which are alleged to have been surrendered in the previous prosecution. Indeed, there is no evidence of surrender. On the contrary, rather than the original prosecution being characterized by argument of the type evidencing a surrender of claims, the prosecution was directed to having applicants' original four claims drafted in a format which complied with 35 U.S.C. §112. The applicants originally submitted four claims, and the original application was issued with four claims. Further, the issued claims are substantially broader in most respects than the original claims submitted, this being the result of a helpful examiner guiding a pro se applicant. The broader issued claims contradict the Examiner's contention that applicants surrendered subject matter during the original prosecution. Unfortunately, the final result was a patent that inadvertently disclosed two embodiments and claimed only one.

More particularly, applicant's error and the reason for the present reissue proceeding is the embodiment shown in Figures 4 and 5 of the Sprague patent, and disclosed in column 4, lines 10-16 (the Figure 4 embodiment). The originally-filed and ultimately-issued claims are directed only to the embodiment shown in Fig. 1, with "*a line of perforations at each of the top, right side and bottom of the package, the bottom line of perforations intersecting the die cut transparent cellophane window to provide a quick release feature that exposes a portion*

---

<sup>2</sup> The Examiner cites Hester Industries, 46 USPQ2d 1641, for the proposition that arguments made to overcome prior art may evidence admission sufficient to give rise to finding of surrender within the meaning of the recapture rule. Hester stands for the proposition that "recapture rule" prohibits grant of reissue claims that are broader than original claims *in manner directly pertinent to subject matter surrendered during prosecution*.

of the data card". This limitation leaves out Fig. 4, which does not have a line of perforations at the bottom of the package intersecting the die cut transparent cellophane window. Instead of being encased, the card of Fig. 4 is suspended. The prosecution record is devoid of any evidence (either claim changes or argument) that Applicant surrendered anything *directly pertinent* to the embodiment of Fig. 4. The recapture rule does not apply in the absence of evidence that the amendment was an admission that the scope of the claim was not patentable. Mentor, 998 F.2d at 995, 27 USPQ2d at 1524; Seattle Box Co. v. Industrial Crating & Packing, Inc., 731 F.2d 818, 826, 221 USPQ 568, 574 (Fed. Cir. 1984). In the present case, there simply is no evidence of any prior admission that the scope of any claim(s) was not in fact patentable. It is abundantly clear from the prosecution history that the inventor (in originally proceeding pro se) erred by disclosing the embodiment of Figs. 4-7 but by failing to claim it. No claims were ever directed to this embodiment and none were ever canceled or surrendered. That is the crux of the error upon which this reissue proceeding is based.

The Examiner's reliance on Hester, which holds that argument alone can effect a surrender, is taken as a concession that the traditional and more obvious manner of evidencing recapture i.e. by claim changes, is not present in the prosecution history of the present patent. Clement, 131 F.3d at 1464, 1469, 45 USPQ2d 1161, 1164, states that "To determine whether an applicant surrendered particular subject matter, we look to the prosecution history for arguments and changes to the claims made in an effort to overcome prior art rejection." The Examiner fails to direct the applicants to any argument in the prosecution history which supports the allegation of surrender of the Fig. 4 embodiment. The Examiner states that the broadening of the instant claims are "relative to a folded one piece board, the board including a diecut transparent window, a data card being included in the folded board, adhesive included to secure the folded board to itself, the board including a quick release perforation feature for opening to reveal the magnetic stripe of the included data card, the one piece board being printed in one pass to provide data on the front and back sides of the board are related to

subject matter surrendered in the original application.” Each feature included in the above quoted recitations (underlined for clarity) was allowed in the issued patent and has been allowed in claims 1-4 of the pending claims. Therefore, the allegation that these features were somehow surrendered in the prosecution of the original application is untenable.

The Examiner also rejected claims 5-6 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 3,508,702 to Kaiser; U.S. Patent No. 3,838,808 to Schroeder; U.S. Patent No. 3,999,700 to Chalmers; and U.S. Patent No. 4,887,763 to Sano. The patents listed above disclose: a credit card mailing assembly; an envelope blank; a credit card mailer; and a transmittal envelope respectively. The structural differences which distinguish the present invention arise largely as a function of the present invention having nothing to do with envelopes for mailing. Nevertheless, to further distinguish claims 5-15 over the mailer references, claim 5 is amended herein to better reflect the following elements: 1) 1-ply folded paperboard; 2) bonded together along margins at the top and side; 3) with perforations inside the margins the separation of which permits the package to unfold. These features are not taught or suggested in any of the mailer references.

More specifically, Kaiser ‘702 is distinguished as a three piece mailing assembly comprising an envelope bearing a transparent window, a first folding member adapted for insertion into the envelope, and a second folding member “adapted for folding along at least *two fold lines* and for holding at least one credit card intermediate said fold lines.” The present invention as recited in amended claim 5 claims a “paperboard backing having first and second sides,...perforations in said paperboard backing defining first and second side margins, said first side being folded over... and bonded along said first and second side margins...whereby separation of said perforations permits the package to unfold.” None of these limitations are taught or suggested by Kaiser ‘702, and claim 5 is patentably distinguished. Claims 6-15 depend from claim 5 and are likewise distinguished.

Schroeder ‘808 teaches an envelope with top, bottom, and side edges and a plurality of flaps. Claim 5 in the present invention is distinguished as having an opaque backing having



first and second panels, first and second panel *margins*. Schroeder '808 has no first side "adapted to be folded over said data card and onto said second side to secure said data card there between" Thus, the Schroeder '808 envelope cannot be accomplished with a single piece of paperboard and with a single overhead fold. None of the limitations discussed above in respect to Kaiser '702 are taught or suggested by Schroeder '808, and claims 5-15 are patentably distinguished.

Chalmers '763 is also similar to Kaiser '702 and yet further removed because it teaches a three piece mailing assembly for credit cards used to completely *mask* the presence of credit cards enclosed therein. The element which receives the card(s), called a "foldable wrapping member" has no window at all and is clearly distinguished from claims 5-15 of the present invention as described above and because a window would defeat the express purpose of Chalmers to conceal the presence of the cards.

Finally, Sano '763 teaches a transmittal envelope for a magnetic card comprising two separate sheets of paper mounted together to form an envelope. This arrangement is clearly distinguished from the data card display of claim 5 in the present invention which claims a single opaque backing folded and bonded in a specific manner to enclose the data card.

Next, the Examiner rejected claims 5-6 and 13 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 5,918,909 to Fiala et al. Fiala '909 is only partially considered to be prior art because only Figures 1-18 therein and the accompanying description are entitled to the claimed priority date. Figs. 19 et seq. teach subject matter which was not disclosed in the priority application filed on April 19, 1996.<sup>3</sup> In Figures 1-18 there is no reference to a

---

<sup>3</sup> The Fiala patent is the grandchild of application Serial No. 08/634,820 filed on April 19, 1996, which was expressly abandoned as of the date of the filing of another application Serial No. 08/711,814 on September 10, 1996. The intervening continuation-in-part (CIP) application 08/711,814 was expressly abandoned as of the date of filing of a third application Serial No. 08/895,283, also a CIP application. A patent applicant who files a continuation-in-part (CIP) application based on an earlier application concedes that there is new subject matter in the CIP application that was not contained in the earlier application. Thus, under the patent laws, only the subject matter disclosed in the initial 08/634,820 application, that is disclosed again in the

construction of the package from paperboard, nor to the method of folding a first panel over a second panel to enclose a data bearing card.

With respect to the display window disclosed in Fiala '909, there are substantial differences.

Fiala '909 teaches that the transparent window is preferably glued between the first and second panels with a PVC glue thereby "gluingly sealing" the first panel to the second panel. The present invention teaches and claims the transparent layer bonded only to the first panel. This structural distinction facilitates a single backing folded to form the final package, with the two panels bonded along the margins.

As stated previously, the present invention as recited in amended claim 5 claims a "paperboard backing having first and second sides,...perforations in said paperboard backing defining first and second side margins, said first side being folded over... and bonded along said first and second side margins...whereby separation of said perforations permits the package to unfold." When opened, the interior of the package reveals printed information to the user. In contrast, Fiala '909 does not teach or suggest perforated margins for opening the package at all.

The Examiner also rejected claims 6-12 and 15 under 35 U.S.C. 103(a) as being unpatentable over Fiala et al. '909. However, claims 6-15 depend from claim 5 and are likewise distinguished.

Next, the Examiner rejected claims 7 and 9-11 under 35 U.S.C. §103(a) as being unpatentable over any one of Kaiser, Schroeder, Chalmers and Sano. The Examiner states that "each discloses the aperture as a window disposed in and bordered on three sides (as well as four) by the first panel, the window disposed in a location of the first panel as claimed." This is incorrect. Kaiser '702 discloses a three piece mailing assembly for credit cards for the

---

second 08/711,814 application, and again in the application that issued as Fiala et al. '989, can be claimed as prior art against the Sprague patent. Only Figures 1-18 fulfill this requirement.

**Applicant submits a marked up Fiala patent herewith with original subject matter highlighted in yellow, and later-added subject matter highlighted in pink.**

purpose of "making it difficult to feel the presence of the credit card in the assembly."

Accordingly, the second foldable member, which represents the element of the assembly in contact with the card(s), does *not* comprise a window at all.

Schroeder '808 claims "an envelope blank according to claim 5, wherein said face has a window." No further reference is made in the Schroeder claims to a window. In view of the arguments presented above distinguishing the envelope blank as disclosed in claim 5 from the data package of the present invention, it follows that the addition of a window to that different structure is not a tenable basis for a §103(a) rejection.

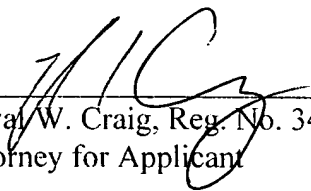
Chalmers '700, like Kaiser '702, teaches an invention to conceal the presence of credit cards during mailing. Accordingly, the foldable wrapping member, the element which receives the cards likewise does not comprise a window or aperture to make the cards visible. Such an element would defeat the purpose of the invention.

Finally, Sano '763 again discloses a transmittal envelope for a magnetic card comprising two separate sheets of paper mounted together to form an envelope. There is an "opening through which the magnetic card is exposed." However, as in Schroeder '808, the structure within which the opening is constructed is entirely different than the structure disclosed in the present invention. This is especially true of the Fig. 4 embodiment as reflected in claims 7 and 11, both of which are clearly distinguished since the Sano opening is bordered on all four sides by the lower sheet of paper. Even in regard to the Fig. 1 embodiment, Sano does not teach or suggest bonded margins with separable perforations in order to open the package. In Sano, perforations are not required because the purpose of the device is to secure the card for mailing. The purpose of the present invention would be undermined if the embodiment describing a diecut window bordered on all four sides were not accompanied by perforations which enabled access to the magnetic stripe of the data card.

Application Number: 09/458,132  
Sprague, William R., et al.  
Page 14-

In view of the above amendments and remarks, it is believed that this application is now in condition for allowance, and such a Notice is respectfully requested.

Respectfully submitted,

  
\_\_\_\_\_  
Royal W. Craig, Reg. No. 34,145  
Attorney for Applicant

Date: 12/15/00

Law Offices of Royal W. Craig, P.C.  
210 North Charles Street, Suite 1319  
Baltimore MD 21201  
Phone: 410-528-8252  
Facsimile: 410-528-1066